

REMARKS

The examiner notes that the status identifiers for claims 41 and 51-54 were wrong. Accordingly, Applicant has changed the status identifiers for these claims to read “withdrawn.”

The drawings stand objected to under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims. Replacement sheet 3/3 has been submitted herewith.

Figure 8 has been added to illustrate a root-tip-trapping region including protuberances having outwardly extending distal ends that are closed to trap roots. Support for this new figure is drawn from the detailed description (especially paragraph 23), as well as the figures and description of US application 10/446,987 which was incorporated by reference into the present application (see paragraph 23). The present specification has also been amended to include new paragraph [0043.2], which describes Figure 8 and is similarly supported. Accordingly, Applicant asserts that no new matter has been entered.

Figure 9 has been added to illustrate two or more root tip trapping regions and two or more air root pruning regions. Support for this new figure is drawn from the detailed description (especially paragraph 23), as well as the figures and description of US application 10/446,987 which was incorporated by reference into the present application (see paragraph 23). New paragraph [0043.3] describes Figure 9 and is similarly supported. Accordingly, Applicant asserts that no new matter has been entered.

Claims 35, 39 & 40 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Regarding claim 35, Applicant has amended paragraph [0011] of the specification to include the subject matter of claim 35, which was part of the specification as originally filed.

Regarding claims 39 and 40, Applicant has amended paragraph [0021] of the specification to include the subject matter of claims 39 and 40, which was part of the specification as originally filed.

Additional specification support for this amendment is found in original paragraph [0021], which disclosed that the “root-tip-trapping and air-root-pruning regions may be configured in various patterns such as rows, columns, dots, checkerboard and the like.” Reconsideration and withdrawal of the rejection is requested.

Claims 11, 46, 63 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 has been amended to provide strict antecedent basis. Claim 46 has been amended to delete the superfluous material. Claim 63 has been amended to depend from claim 3, which is believed to provide proper antecedent basis for the various terms in the claim. The Applicant thanks the examiner for careful attention to this matter. Reconsideration and withdrawal of the rejection is requested.

Claims 1, 2, 7, 37, 63 stand rejected under 35 U.S.C. 102(a) as being anticipated by Reiger (6202348).

Claim 1 is set out as follows (*emphasis added*):

A sidewall for a plant container, comprising:
a substantially water-impermeable root-tip-trapping region; and
a porous air-root-pruning region adjacent the root-tip-trapping region,
wherein the root-tip-trapping region is a *contiguous* upper portion of the sidewall and
the air-root-pruning region is a *contiguous* lower portion of the sidewall.

In support of the rejection, the examiner asserts that “there are no breaks or interruption in the sidewall for the air root pruning region, hence, contiguous.” (Office Action dated March 17, 2009, page 4). The examiner’s interpretation of the air root pruning region is shown in the examiner’s self-annotated figure. (Office Action dated March 17, 2009, page 5; *see* the annotated figure derived from Reiger 6,202,348, Figure 8, but including additions and deletions).

The examiner also directs attention to page 8 of the Board's Decision of June 13, 2008. The relevant portion of that Decision is set out as follows:

Reiger's plastic sidewall 142 also includes a plurality of drain holes 146 (Fig. 8; col. 7, ll. 52-54). Because the fabric liner 120 adjacent these drain holes is exposed to air, we determine that this adjacent fabric liner inherently performs the air-root-pruning function recited in claim 1. *See In re Cruciferous Spout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002)(A prior art reference may anticipate when the claim limitations not expressly found in the reference are nonetheless inherent in it).

Our determination is reasonable since Reiger expressly teaches that root tips are capable of penetrating the fabric liner and thereupon stop growing when directed into the sidewall 142 of pot 115 (col. 8, ll. 38-48). Because no sidewall 142 exists at the regions defined by drain holes 146, the afore-noted roots which penetrate the fabric liner in those drain hole regions would be necessarily exposed to air and pruned thereby in the same way as roots are air pruned in Appellant's claimed air-root-pruning region. *See Ex parte Levy*, 17 USPQ2d 1461, 1463-64 (BPAI 1990)(inherency must be reasonably supported by a basis in fact and/or technical reasoning).

Under these circumstances, Reiger's fabric liner regions adjacent drain holes 146 satisfy the claim 1 requirement for "a porous air-root-pruning region adjacent the root-tip-trapping region."

(BPAI Decision of June 13, 2008, pages 8-9; *underlining added*)

Although little if any air-root-pruning may occur at Reiger's drain hole regions, the Applicant's present argument is not taking issue with the finding of the Board. However, the Board's finding must be read clearly. The Board has stated that air-root-pruning would occur in the fabric liner adjacent the drain holes 146. The Board's use of the word "adjacent" must be understood in the context of the Board's full statement that "[b]ecause no sidewall 142 exists at the regions defined by drain holes 146, the afore-noted roots which penetrate the fabric liner in those drain hole regions would be necessarily exposed to air and pruned thereby . . ." (BPAI Decision of June 13, 2008, page 8, lines 22-25). Accordingly, the fabric regions (plural) where there is no sidewall 14 are limited to the fabric regions immediately behind and aligned with the drain holes.

The Board's foregoing statements were made only with regard to independent claim 1, as pending at the time of the appeal. In the Applicant's Response to the Decision, filed on Sept. 5, 2008, claim 1 was amended to include the limitation of claim 4, which stated "wherein the root-tip-trapping region is a contiguous upper portion of the sidewall and the air-root-pruning region is a contiguous lower portion of the sidewall." Accordingly, the Board's statements were not made in reference the present scope of claim 1. Furthermore, the Applicant asserts that the Board's statement makes it clear that they only found air-root-pruning to occur at the drain hole regions (plural).

The examiner's assertion via the figure on page 5 of the Office Action extrapolates the discrete drain hole regions of Reiger into an arbitrary zone that is unsupported by Reiger. The examiner's annotation of the Reiger's figure 8 to show the arbitrary air root pruning region is the result of impermissible hindsight reasoning. There is no valid basis for the examiner's finding.

Claim 1 includes the limitation that the air-root-pruning region is a *contiguous* lower portion of the sidewall. One example of an air-root-pruning region that is a contiguous lower portion of the sidewall is shown as region 20 in Figure 1 of the present application. The word "contiguous" is used in its ordinary sense to mean touching or connected throughout in an unbroken sequence. Reiger's drain hole regions are, in fact, a plurality of discrete and separate regions that are not contiguous.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984). Under 35 U.S.C. Section 102, anticipation requires that "the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Similarly, the Federal Circuit has stated that "[a]n

anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention.” *ATD Corp v. Lydall, Inc.* 159 F.3d 534 (Fed. Cir. 1998).

The Court of Appeals for the Federal Circuit has recently reaffirmed that examiners must interpret claim terms in a manner that is consistent with the specification. The case of *In re American Academy of Science Tech. Center* is cited in the Manual of Patent Examining Procedure, Section 211.01 entitled “Plain Meaning.” According to this Federal Circuit opinion, “[d]uring examination, ‘claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re American Academy of Science Tech Center*, 367 F.3d 1359 (Fed. Cir. 2004). Accordingly, it is required that claim terms be read in light of the specification and interpreted consistent with the specification. The M.P.E.P. Section 2111.01, Subsection III, entitled “Applicant May Be Own Lexicographer,” emphasizes that:

The specification should also be relied on for more than just explicit lexicography or clear disavowal of claim scope to determine the meaning of a claim term when an applicant acts as his or her own lexicographer; the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in context in the specification. See *Phillips v. AWH Corp.*, 363 F.3d 1207, 75 USPQ2d 1321 (Fed. Cir. 2005)(*en banc*); and *Vitronics Corp. v. Conceptronic Inc.*, 90 f.3d 1576, 1583 USPQ2d 1573, 1577 (Fed. Cir. 1996).

Reconsideration and withdrawal of the rejection is requested.

Claims 3, 12, 14-20, 26, 27, 32, 33, 46-50, 64, 67, 68 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as applied to claim 1 above, and further in view of Reynolds et al. (3080680).

Claims 3, 12, 14-20, 26, 27, 32, 33, 46-50, and 64 depend directly or indirectly from independent claim 1. These claims are believed to be patentable for at least the same reasons as claim 1, asserted above. Claims 67 and 68 depend directly or indirectly from independent claim 65, and are believed to be patentable for at least the same reasons as claim 65. The patentability of claim

65 is discussed below. Reconsideration and withdrawal of the rejection is requested.

With respect to claim 64, the examiner states that it would be obvious to have the layer of root impenetrable material disposed over $\frac{1}{2}$ to $\frac{9}{10}$ of the porous fabric layer of Reiger as modified by Reynolds et al., “depending on the type of plant being grown because different plants might need different air root pruning, thus, if a plant needs less air root pruning, then the sidewall would be made more of a root tip trapping region than air root pruning region.” (Office Action dated March 17, 2009, page 10, lines 3-8). The examiner has failed to recite any basis for these assertions and appears to be taking official notice. Applicant respectfully requests that the examiner provide support for the premise that “different plants might need different air root pruning.”

Claims 5, 6, 13, 65, 66, 69 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger (as above).

Regarding claims 5, 6, 65 and 66, the examiner states that it would be obvious to have the root-tip-trapping region comprise between $\frac{1}{2}$ and $\frac{9}{10}$ or between $\frac{2}{3}$ and $\frac{3}{4}$ of the sidewall of Reiger, “depending on the type of plant being grown because different plants might need different air root pruning, thus, if a plant needs less air root pruning, then the sidewall would be made more of a root tip trapping region than air root pruning region.” (Office Action dated March 17, 2009, page 10, lines 3-8). The examiner has failed to recite any basis for these assertions and appears to be taking official notice. Applicant respectfully requests that the examiner provide support for the premise that “different plants might need different air root pruning.”

Reconsideration and withdrawal of the rejection is requested.

Claims 8, 9, 11, 36, 38-40, 70-72 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as applied to claim 1 above, and further in view of Whitcomb et al. (4939865).

Claims 8, 9, 11 and 38 depend directly or indirectly from independent claim 1. These claims are believed to be patentable for at least the same reasons as claim 1, asserted above.

However, regarding claim 11, the Applicant asserts that the combination of sewing together the edges of Reiger's fabric liner and hooking the edges of Whitcomb's sidewall, would still not produce a sidewall wherein the root-tip-trapping region is a contiguous upper portion of the sidewall and the air-root-pruning region is a contiguous lower portion of the sidewall, in accordance with claim 1.

Regarding independent claim 70, the rejection reasserts the examiner's comments regarding claims 1 and 8. The Applicant believes that claim 70 are patentable for at least the same reasons as claims 1 and 8.

Regarding claim 36, the rejection reasserts the examiner's comments regarding claim 69. Claims 36 and 69 are not of the same scope, because they depend from different independent claims. Still, the Applicant believes that claim 36 is patentable for at least the same reasons as claim 1.

Regarding claims 39 and 40, the rejection asserts that "since there is no boundary defined in Applicant's invention regarding regions, the examiner is considering the regions as illustrated below as taught by Reiger as modified by Whitcomb et al. (emphasis on Reiger)." (Office Action dated March 17, 2009, page 13, lines 11-13; referring to the examiner's annotated figure on page 14; and page 14, lines 1-3; referring to the examiner's annotated figure on page 15).

Figure 1 of the present application clearly shows the boundary between a root-tip-trapping region 13 and an air-root-pruning-region 20. (Specification, Figure 1 and para. [0038]). The examiner's assertion, via the annotated figures on pages 14 and 15 of the office action, that two regions can be found where there is no boundary setting apart the regions is inconsistent with the present specification as well as the ordinary meaning of a region.

Regarding claims 71-72, the rejection reasserts the examiner's comments regarding claim 5. The Applicant believes that claims 71-72 are patentable for at least the same reasons as claims 1 and 5.

Reconsideration and withdrawal of the rejection is requested.

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as applied to claim 1 above, and further in view of Whitcomb et al. (4716680). Claim 10 depends from claim 1 and is patentable for at least the same reasons as claim 1. Furthermore, there is no suggestion to combine Reiger and Whitcomb because these references both assert to trap roots achieve the benefits of preventing spiral root growth and maximizing development of lateral roots. If Reiger discloses root trapping, why would Reiger suggest using some other means to trap roots. Reconsideration and withdrawal of the rejection is requested.

Claim 21 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. as applied to claims 1, 3 above, and further in view of Thomas (5311700). Claim 21 indirectly depends from claim 1 and is patentable for at least the same reasons as claims 1 and 3. Reconsideration and withdrawal of the rejection is requested.

Claims 22-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. as applied to claims 1, 3 above, and further in view of Berlit et al. (GB 2073567). Claims 22-24 indirectly depend from claim 1 and are patentable for at least the same reasons as claims 1 and 3. Reconsideration and withdrawal of the rejection is requested.

Claims 25, 29 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. as applied to claims 1, 3 above, and further in view of Van der Goorbergh (EP 300578A3). Claims 25, 29 and 31 indirectly depend from claim 1 and are patentable for at least the same reasons as claims 1 and 3. Reconsideration and withdrawal of the rejection is requested.

Claims 28, 34 and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. as applied to claims 1, 3 above, and further in view of Flasch (5852896). Claims 28, 34 and 35 indirectly depend from claim 1 and are patentable for at least the same reasons as claims 1 and 3. Reconsideration and withdrawal of the rejection is requested.

Claim 30 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. and Berlitz et al. as applied to claims 1, 3, 22 above, and further in view of Flasch (as above). Claim 30 indirectly depends from claim 1 and is patentable for at least the same reasons as claims 1 and 3. Reconsideration and withdrawal of the rejection is requested.

Claims 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Whitcomb et al. as applied to claim 70 above, and further in view of Reynolds et al. (as above). Claims 73-74 directly or indirectly depend from claim 70 and are patentable for at least the same reasons as claim 70.

Furthermore, the examiner relies upon his previous explanations of claim 3 and 46 as support the rejection. However, it should be realized that claims 73-74 depend from independent claim 70, whereas claims 3 and 46 depend from independent claim 1. Still further, even the examiner's rejection of claim 70 relies upon the rejection of claims 1 and 8. The rejection relies so heavily upon prior statements that it is difficult to understand. Accordingly, the Applicant asserts that the examiner has not provided a clear statement of the rejection that enables an adequate response.

The rejection also fails to state any basis for combining the references. Therefore, the rejection has not established a prima facie case of obviousness.

Even further, it is not understood how the combination of references could be made to function. The asserted layers of Whitcomb and Reynolds would seem be redundant. Reconsideration and withdrawal of the rejection is requested.

Entry and consideration of the foregoing amendments and remarks is requested. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/WHIT/0002.A of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,

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